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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,098	11/21/2003	Terrence A. Tomkow	RPOST-66231	1930
24201	7590	12/07/2007		
FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER GELAGAY, SHEWAYE	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 12/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/719,098

Applicant(s)

TOMKOW, TERRENCE A.

Examiner

Shewaye Gelagay

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This office action is in response to Applicant's amendment filed on September 24, 2007. Claims 1-20 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 9/24/07 have been fully considered but they are not persuasive. In response to applicants arguments the following comments are made:  
The applicant argued that Tomkow does not disclose or even suggest providing for transmission of a reply to the sender through the server of the message by the recipient. The examiner respectfully disagrees. Applicant disclosure on page 18, paragraph 93 teaches "Additionally, the tag may contain instructions, World Wide Web addresses, or links that invite and allow the recipient to send a reply made of record to the message by linking to a Web Page from which messages made of record may be composed and sent." Consistent with the applicant teaching Tomkow discloses a system that provides instructions, World Wide Web addresses, or links that invite and allow the recipient to send a registered reply the message by linking to a Web Page from which registered messages may be composed and sent. (page 12, lines 21-24)

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Tomkow WIPO Publication WO 01/10090.

As per claim 1:

Tomkow teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message at the server from the sender, (page 4, lines 6-9) transmitting the message from the server to the recipient, (page 4, lines 9-11) and providing for a transmission of a reply to the sender through the server of the message by the recipient. (page 10, lines 11-15)

As per claim 2:

Tomkow further teaches the message is provided with a unique identification by the server and wherein the reply from the recipient through the server to the sender is provided on the basis of this unique identification of the message by the server. (page 16, line 1-15)

As per claim 3:

Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message. (page 16, lines 10-23)

As pr claim 4:

Tomkow further teaches wherein the message from the sender to the recipient is provided in a particular format at the server. (page 16, lines 24-28)

As per claims 5 and 16:

Tomkow further teaches wherein the reply includes a request from the recipient to receive proof of transmission or delivery of the reply and wherein the server responds to the request in the reply to provide the proof of the transmission or delivery of the reply to the sender. (page 6, lines 6-25; page 16, lines 16-28)

As per claims 6 and 16:

Tomkow further teaches wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6)

As per claims 7 and 12:

Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message and wherein the message from the sender to the recipient is provided in a particular format at the server and wherein the reply includes a request from the recipient to receive proof of

transmission or delivery of the reply and wherein the server responds to the request in the reply to provide the proof of the transmission or delivery of the reply to the sender and wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

As per claims 8 and 11:

Tomkow teaches transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message at the server from the sender, (page 4, lines 6-9) transmitting the message from the server to the recipient, (page 4, lines 9-11) providing a database identifying the message and the sender including the address of the sender, (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) locating in the database the identification of the message and the sender, (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) and transmitting to the sender through the server any reply by the recipient to the sender (page 10, lines 11-15)

As per claims 9 and 13:

Tomkow further teaches wherein the message is provided with a unique identification by the server and wherein the sender is provided with a unique identification related to the unique identification of the message and wherein the server determines the identification and address of the sender through the identification of the message and wherein the server transmits the reply to the address of the sender. (page 16, lines 1-15; page 20, line 10-page 21, line 6)

As per claim 10:

Tomkow teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the individual identification of the message. (page 6, lines 6-25; page 16, lines 16-28)

As per claim 14:

Tomkow teaches transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message from the sender, (page 4, lines 6-9) assigning the message a unique identification, (page 16, lines 1-15) storing the unique identification of the message and the sender address in an address in a database, (page 10, line 5-page 11, line 14) sending the message to the recipient, (page 4, lines 9-11) providing a reply to the message at the recipient, (page 10, lines 11-15) sending the reply to the server with the unique identification of the message, (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) extracting the unique identification of the message in the reply, (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) obtaining the address of

the sender from the database on the basis of the unique identification of the message in the database, (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) re-addressing the reply to the sender, and sending the reply to the sender. (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6)

As per claim 17:

Tomkow further teaches wherein a delivery receipt is generated from the reply from the recipient to the sender and wherein the delivery receipt is transmitted to the sender and the recipient. (page 22, line 15-page 23, line 30)

As per claim 18:

Tomkow further teaches wherein the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format. (page 15, line 13-page 16, line 23)

As per claim 19:

Tomkow further teaches a wherein the reply from the recipient is sent registered from the server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender and the recipient. (page 15, line 13-page 16, line 23)

As per claim 20:

Tomkow further teaches wherein the server also sends the reply to the recipient to confirm that the recipient has sent the reply to the sender the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format and wherein the reply from the recipient is sent registered from the



server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender and the recipient. (page 25, lines 4-30)

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gelagay



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER